

PATENT
IBM Docket No. JP920000247US1

PRELIMINARY REMARKS

Examiner has rejected Claim 9 under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Examiner has also rejected Claims 6 and 9 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Examiner has rejected Claims 1-4 and 10-12 under 35 U.S.C. §102(b) as being anticipated by Helot, U.S. Patent 6,091,602 (hereinafter, Helot). Examiner has also rejected Claims 5-9 under 35 U.S.C. §102(b) as being anticipated by Honda et al., U.S. Patent 5,619,397 (hereinafter, Honda). Applicant has newly added Claims 13 and 14.

APPLICANT'S REMARKS

Applicant has provided a complete set of all pending Claims. Applicant has canceled Claims 2, 8-9, and 12, thus rendering moot Examiner's rejections for those claims. Applicant has amended Claims 1, 5-7 and 10-11, and has responded to each of Examiner's assertions rendering the basis for the 35 § U.S.C. 112 and 35 U.S.C. §102(b) rejections moot. Applicant has also newly added Claims 13 and 14. Applicant has also amended two (2) paragraphs in the specification to fix editing errors and a replacement for Figure 7. Support for each can be found in the specification and/or Figures. It is believed no new matter is introduced. In view of such, Applicant respectfully requests removal of all rejections, reconsideration all claims, and a timely notice of allowance to optimize Applicant's statutory patent term.

Claim 9 Rejections Under 35 U.S.C. §112, first paragraph and second paragraph

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Applicant has canceled Claim 9, thus rendering moot Examiners rejections with respect to this claim. However, Applicant disagrees with Examiner's assertion that the pocket is the holding member. See OA, item 5, Page 3, Lines 6 and 7. Applicant presents multiple preferred embodiments where each embodiment teaches a different holding member. Applicant refers Examiner to the following specific Figures and references in the specification:

Page 4 starting at line 10 and ending at line 11,
Page 6 starting at line 21 and ending at line 24,
Page 7 starting at line 11 and ending at line 12,
Page 8 starting at line 6 and ending at line 11,
Page 8 starting at line 18 and ending at line 21,
Figures 1, 9, 14 and 19,

These references and Figures are examples of Applicant's multiple and diverse holding members and are not intended to limit the scope of Applicant's claimed invention. Applicant states on the Page 7 reference, supra, "The pocket of this connection enhancement apparatus is one of the forms of the holding member." If Examiner disagrees with Applicant, Applicant requests that Examiner identifies where in the specification the Examiner believes there is only a single form of the holding member.

Claim 6 Rejections Under 35 U.S.C. §112, second paragraph

Applicant has amended Claim 6 to more precisely claim the present invention upon which to set forth changes that overcome Examiner's rejection under 112, second paragraph. Applicant now believes Claim 6 is in condition for allowance. It is believed no new matter has been added.

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Claims 1-4 and 10-12 Rejections Under 35 U.S.C. §102(b)

Applicant has canceled Claims 2 and 12, thus rendering Examiner's rejection of Claims 2 and 12 moot.

Claims 1-4

Applicant has amended Claim 1 to more precisely claim Applicant's invention. Applicant has added the below underlined text to Claim 1:

"...a housing defining a mounting surface having a pocket formed therein, wherein the mounting surface is a surface on said housing selected from the group consisting of a surface with the largest area and a surface essentially parallel to a plane containing the surface with the largest area:..."

There is support throughout Applicant's Specification and Figures at least on, Page 17, starting at line 22 and ending at line 25, and Figure 19.

Helot teaches a front surface 26 in Figure 1 and Column 3, line 12. Unlike Applicant's front surface, which uses the surface with the largest area, the apparatus 10 of Helot's teachings does not use a front surface 26 with the largest area. Helot's teachings defines the surface with the largest area of apparatus 10 to be the top surface 22, see Figure 1 and Column 3, line 12.

Nor would it be obvious to one of ordinary skill in the art to combine the teachings of Helot with any of the Examiner's referenced art to render obvious Applicant's invention

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at least because no combination of the references teach or suggest all of the claimed elements and limitations.

With this amendment, Applicant believes amended Claim 1, and therefore Claims 3 and 4 depending therefrom, are now patentably distinct over the Examiner's cited prior art. Applicant believes no new matter has been added.

Claims 10 and 11

Applicant has also amended Claims 10 and 11 to more precisely claim Applicant's invention. Applicant has added the below underlined text to Claim 10:

"...a vertically oriented connection enhancement apparatus adapted to support connections of a plurality of I/O ports and defining a front surface having a pocket formed therein, wherein the front surface is a surface on said connection enhancement apparatus selected from the group consisting of a surface with the largest area and a surface essentially parallel to a plane containing the surface with the largest area :..."

Support can be found in the specification and/or Figures at least in the Specification on Page 4 starting at line 8 and ending at line 11, and original Claim 1, starting at line 6 and ending at line 8.

Helot teaches a front surface 26 in Figure 1 and Column 3, line 12. Unlike Applicant's front surface, which uses the surface with the largest area, the apparatus 10 of Helot's teachings does not use a front surface 26 with the largest area. Helot's teachings defines the surface with the largest area of apparatus 10 to be the top surface 22, see

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Figure 1 and Column 3, line 12.

Nor would it be obvious to one of ordinary skill in the art to combine the teachings of Helot with any of the Examiner's referenced art to render obvious Applicant's invention at least because no combination of the references teach or suggest all of the claimed elements and limitations.

With this amendment, Applicant believes amended Claim 10, and therefore Claim 11 depending therefrom, also amended to improve its cadence, are now patentably distinct over the Examiner's cited prior art. Applicant believes no new matter has been added.

As such, Applicant believes Claims 1, 3- 4 and 10-11 are now in condition for allowance.

Claims 5-9 Rejections Under 35 U.S.C. §102(b)

Applicant has canceled Claims 8 and 9, thus rendering Examiner's rejection of Claims 8 and 9 moot. Applicant has amended Claims 5-7 to more precisely claim Applicant's invention.

Claims 5 and 7

Applicant had added the underline text below to Claim 5:

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"...a housing, having a mounting surface wherein the mounting surface is a surface on said housing selected from the group consisting of a surface with the largest area and a surface essentially parallel to a plane containing the surface with the largest area, and adapted to house a portable information processing apparatus in a position substantially vertical to an installation surface on which the portable information processing apparatus is installed;..."

Support for the word -mount- can be found throughout the Specification, for example see Page 7 starting at line 11 and ending at line 30. One of ordinary skill in the art would understand the use of the word "mount" in place of -attach- or -install- for installing the apparatus in the pocket. Examiner asserts that the connector members 111a and 111b of Honda's teachings are the connector member 8 of Applicant's invention. Applicant respectfully disagrees, connector member 111a and 111b of Honda's teachings are "...boss portions 111a and 111b formed on an upper portion of the rear panel 82 via a pivot shaft 112....," Column 9, starting at line 55 and ending at line 57. Applicant's connector member 8 is a connector for carrying electrical signals between the docking station 1 and portable information processing apparatus 12 of Applicant's teachings.

Examiner also asserts that Honda teaches a stopper (144, 145, 154, 155) that is a sliding table, Figure 1. Applicant has added the text "... is rail mounted and holds ..." to Claim 7 to more specifically claim Applicant's invention. Honda's stopper is fixed at one end of the structure and leans either toward or away from the connecting portion 81, unlike Applicant's stopper 13 which is not fixed at either end and moves forward and backwards on rails 13b.

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Nor would it be obvious to one of ordinary skill in the art to combine the teachings of Helot with any of the Examiner's referenced art to render obvious Applicant's invention at least because no combination of the references teach or suggest all of the claimed elements and limitations.

With this amendment, Applicant believes amended Claim 5, and therefore Claim 7 depending therefrom, as amended, also are now patentably distinct over the Examiner's cited prior art.

Claim 6

Applicant has rewritten Claim 6 as an independent claim to include the limitations of the base claim and all intervening claims. Support can be found in original Claims 1 and 2, and in the Specification. Also, Applicant newly recites the underlined text below:

"...a housing having a mounting surface wherein the mounting surface is a surface on said housing selected from the group consisting of a surface with the largest area and a surface essentially parallel to a plane containing the surface with the largest area, and adapted to house a portable information processing apparatus in a position substantially vertical to an installation surface on which the portable information processing apparatus is installed:..."

Also, for the reasons stated supra in relation to Claim 5, Honda does not anticipate Applicant's invention. Nor would it be obvious to one of ordinary skill in the art to combine the teachings of Helot with any of the Examiner's referenced art to render obvious Applicant's invention. Applicant believes no new matter has been added.

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As such, Applicant believes Claims 5-7 are now in condition for allowance.

Newly Added Claims 13-14

Claims 13-14 have been introduced as of this amendment and further define subject matter which is believed patentably distinct from the references cited. Claim 13 newly recites:

“...a housing defining a mounting surface having a pocket formed therein, wherein the mounting surface is a surface on said housing selected from the group consisting of the surface with the largest area and the surface essentially parallel to a plane containing the surface with the largest area ;

a rotatable member extended from said housing; and

an enhancement connector, disposed on said rotatable member, which supports connection to a plurality of I/O ports of a portable information processing apparatus;...”

Support for Claim 13 can be found at least in Figures 14 -18, and the Specification starting at Page 21 at line1 and ending on Page 22 at line 6. Examiner's cited references do not recite all of Applicant's newly claimed elements and limitations. Nor would it be obvious to one of ordinary skill in the art to combine the teachings of any of the Examiner's referenced art to render obvious Applicant's new Claim 13 at least because no combination of the references teach or suggest all of the claimed elements and limitations.

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For example, Examiner asserts the housing (30, 31, 32) of Honda's teachings is Applicant's housing 1. Applicant respectfully disagrees, Honda's does not teach or suggest "... a pocket formed therein..." as newly recited in Applicants Claim 13, see Figure 2 of Honda.

Claim 14 newly recites "...mounting surface is lower in vertical height...." Applicant believes this further distinguishes Applicant's invention as patentable. Support for Claim 14 can be found in Figures 19-21 and the Specification starting at Page 22 at line 7 and ending on Page 23 at line 25.

For the reasons given above, it is the position of Applicant that Claim 13-14 further define inventions which are patently distinct from the references cited. Applicant believes no new matter has been added.

Changes to the Specification

Applicant has amended the paragraph on Page 16 starting at line 20 and ending at line 25 to improve the cadence and grammar. Applicant has also amended the paragraph on Page 21 starting at line 8 and ending at line 13 to improve the readability. Support for the latter change can be found in both the original Specification on page 21 and Figures 14 and 15.

Changes to the drawings

Applicant has amended Figure 7 to change label 12a2 on the bottom of the body 12a of lap-top PC 12. This label has been amended to read 12a3. Support for this can be found throughout the Specification and Figures and at least on Page 15, starting at line

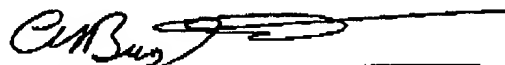
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21 and ending at line 23. Support can also be found in Figures 3, 5, 8, 11, 13, 16 and 18. Therefore, Applicant believes no new matter has been added.

Conclusion

In view of the foregoing it is believed that this case has been placed in condition for a notice of allowability and early notice to that effect is earnestly solicited. Should the Examiner wish to have a telephonic discussion of the positions here taken, the courtesy of a telephone call prior to any forthcoming rejection would be greatly appreciated.

Respectfully Submitted,



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